

REMARKS

This application has been carefully reviewed in light of the Office Action mailed November 5, 2004. Claims 1, 11, 20 and 26 have been amended. Reconsideration and favorable action are requested.

Election/Restriction

Without addressing the merits of the restriction requirement, Applicant respectfully submits that the requirement in the present Office Action is improper at least because it fails to comply with the procedural requirements of the M.P.E.P. for restrictions. The M.P.E.P. makes it clear that restriction is proper only when inventions are either independent or distinct, Section 803, and any restriction requirement must set out: (a) the reasons why the inventions as claimed are either independent or distinct and (b) the reasons for insisting upon restrictions therebetween. Section 808.

In this case, the Office Action failed to even specify whether it alleged there were two distinct inventions or whether there were two independent inventions, stating merely that "newly submitted claims 29-31 are directed to an invention that is independent or distinct" (emphasis added). By not even stating whether the Office Action contends the inventions are independent, or whether they are distinct, the Office Action has failed to comply with the requirements of Section 808.

The only reason stated that the two inventions were independent or distinct was that "these claims are for determining configuration data by determining whether the current configuration data should be reconfigured – classifiable in claim [sic] 711 subclass 152." But this statement, even if it were correct, does not establish independent inventions; it is only an assertion (an incorrect one) that particular claims are classifiable in a particular class. (See M.P.E.P. 808.01 regarding how to establish whether two inventions are independent.) Further, no statement has been made that the Office Action considers Claims 29-31 to be in a separate class from Claims 1-28, which would be required if the Office Action intended to establish that the two groups of claims were distinct because they were in different classes. Applicant respectfully submits that if the Examiner intended to show the two sets of claims were distinct, that the Office Action has failed to provide any of the reasons required by Section 808.02 of the M.P.E.P., such as (a) separate classification, (b) a separate status in the art, or (c) different field of search.

With respect to the assertion that Claims 29-31 are "for determining configuration data by determining whether the configuration data should be reconfigured" Applicant submits that this is clearly incorrect. Rather, Claim 29 recites "a method for card activation in a network element" that involves transitioning into a power up state, communicating a signal at least partially identifying the card, receiving an executable file, storing the file while preventing the processor from accessing memory, and executing the executable file. Perhaps the Examiner is confusing Claim 29 with the cited reference, *Chieng*, which does involve determining whether to use substitute boot instructions or standard boot instructions. See *Chieng* at Col. 3, lines 48-54.

As the present restriction requirement clearly fails to comply with the requirements of the M.P.E.P. and would be overturned on petition, Applicant respectfully requests reconsideration and removal of the requirement. If the Examiner wishes to reassert restriction between the two identified groups, Applicant respectfully submits that such restriction must be made in an Office Action (as opposed to an Advisory Action) that allows Applicant the opportunity to challenge any new grounds for restriction, if appropriate, and establish a record for petition. If the restriction requirement is withdrawn, Applicant respectfully requests allowance of Claims 29-31 (whether or not this amendment is entered), as Claims 29-31 have not been rejected.

Section 103 Rejections

The Office Action rejects Claims 1-3, 8-13, 17-21 and 26-28 under 35 U.S.C. § 103(1) as being unpatentable over *Chieng*. Applicant respectfully traverses. Claim 1, as amended, recites "automatically placing the card in a reset mode in response to powering up of the card" and "in response to placing the card in a reset mode: communicating a signal . . . retrieving an executable file . . . and downloading the executable file to a memory . . . without requiring the use of boot code on the card." This combination of limitations is not shown by the cited reference, *Chieng*. In particular, *Chieng* does not disclose "automatically placing the card in a reset mode in response to powering up of the card" and "in response to placing the card in reset mode" performing the claimed acts. Rather, in *Chieng*, the host processor sends a command to the PCI device when the host processor desires to download substitute boot program instructions. Col. 3, lines 33-34. In addition, the PCI device executes either the substitute boot program instruction or boots in a standard manner, depending on whether a particular signature pattern is found. Col. 3, lines 47-54. In this

manner, *Chieng* can update boot programming on the PCI device when desired, but *Chieng* does not disclose the above-described limitations including automatically placing the card in reset mode and performing particular acts upon being powered-up. According to one embodiment, such acts allow for the elimination of certain non-volatile memory from the associated card.

For at least these reasons Claim 1 is allowable, as are the claims depending therefrom. Independent Claims 11, 20, and 26 are allowable for analogous reasons, as are the claims depending therefrom. Reconsideration and favorable action are requested.

CONCLUSION

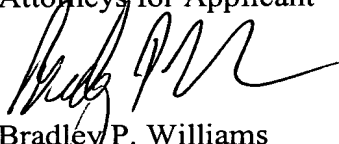
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6447.

Applicant does not believe that any fees are due. However, the Commissioner is hereby authorized to charge these fees and any extra fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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